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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.     | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------|------------------|
| 09/897,229  | 07/02/2001  | Hanspeter Reust      | 103824-458-cip          | 9023             |
| 7590  | 11/05/2003  |                      | EXAMINER                |                  |
| Eva Tan<br>Goodioin Procter LLP<br>7 Becker Farm Road<br>Roseland, NJ 07068 |             |                      | YU, GINA C              |                  |
|   |             |                      | ART UNIT                | PAPER NUMBER     |
|   |             |                      | 1617                    |                  |
|   |             |                      | DATE MAILED: 11/05/2003 |                  |

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Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/897,229             | REUST, HANSPIETER   |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Gina C. Yu             | 1617                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 15 April 2003.

2a) This action is FINAL.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,2,7-10,17 and 22 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,2, 7-10, 17, 22 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

|  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 15, 2003 has been entered. Claims 1, 2, 7-10, 17, and 22 are pending.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 7-10, 17, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites imidazolidinyl urea [sic] to be further added in the composition of claim 1, which already contains the same preservative. It is not clear whether claim 2 necessarily requires an additional preservative.

Claim 7-10, and 17 depend on claim 3, which has been canceled.

Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the method step of how the formulation of the cosmetic product is completed.

***Claim Objections***

Claims 2 and 18 are objected to because of the following informalities: the term "imidazolidinyl urea [sic]" as recited in claim 2, line 3 and claim 18, line 4 contains a typographical error. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1, 2, 7, 8, 10, 17, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips et al. (U.S. Pat. No. 5,580,491) ("Phillips") in view of Costa et al. (U.S. Pat. No. 6,126,953) ("Costa") and Boothe et al. (U.S. Pat. No. 4,764,365) ("Boothe").

Phillips teaches in Example 5 a method of preparing whey-containing shaving cream composition which comprises admixing a microfiltered whey protein *solution* containing 5% of solids, ethanol and oil, and heating the mixture to 74 °C for 10 minutes at 2500 psi, and then cooling to 25 °C. See instant claims 1 and 3. Examiner views that the microfiltered whey protein isolation *aqueous solution* is a mixture of whey powder in a liquid carrier.

The Phillip reference further teaches that the mixture is stored for 30 days before formulating into a shaving cream. Examiner views that the prior art meets the limitation of "premix" in the instant claim 1. Examiner also views that although the reference does not mention whether the water used there is distilled or deionized water, given the teaching of using water in the whey solution for the use of food or cosmetic use in the

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reference, a skilled worker would have obviously used either type of purified water in order to eliminate the possibility of contamination. See instant claim 10. While he reference lacks the teaching of heating the mixture between about 50 °C and its boiling point for 20-60 minutes as instant claims 7 and 8 require, however, examiner views that, given the teaching of heating the mixture at 74°C for 10 minutes, a skilled worker would have known to vary the heating temperature and time. See instant claim 9. The reference also teaches adding the whey mixture to formulate a foaming composition. See Example 1; instant claim 22. While the claimed method consists essentially of the recited method steps, examiner notes that, for the purposes of searching for and applying prior art under 35 U.S.C. § 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, PPG Industries v. Guardian Industries, 156 F.3d 1351, 1355, 48 USPQ2d 1351, 1355 (Fed. Cir. 1998).

The reference teaches that cosmetic additives, including antimicrobial actives, may be added to the composition in conventional way, while it is silent as to the specific types of the additives. See col. 2, line 62 - col. 3, line 7.

Giddey teaches that it is well known in cosmetic art to use an "active complex" derived from whey constituents. See col. 1, lines 28 – 38. The reference also teaches that the complex is produced under reduced pressure followed by centrifuging and finally drying. See instant claim 9. The reference further teaches that it is well known to add whey derivatives to the mixture of ingredients of cosmetics, either in the form of

aqueous solutions or in solid form. See col. 2, lines 34 – 53. The reference also teaches that it is also well known to further add inhibiting agents or germicides to the cosmetics to ensure the preservation of the composition. See col. 2, lines 54 – 60. The Giddey patent teaches using biocides such as imidazolidinyl urea, p-hydroxybenzoic esters, which is paraben, and phenoxyethanol. See col. 4, lines 42 – 46; instant claim 7.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the whey mixture of Phillips by adding the biocides such as imidazolidinyl urea, parabens and phenoxyethanol, as motivated by Giddey, because of an expectation of successfully preserve the composition from microbial contamination during the storage.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 2, 7-10, 17, and 22 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

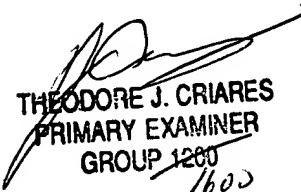
No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu  
Patent Examiner

  
THEODORE J. CRIARES  
PRIMARY EXAMINER  
GROUP 1200  
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